

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PHILLIP E. KECK, DAVID J. ARTEMAN  
DAVID A. FELL, JERRY A. JOHNSTON  
and LYNN K. WEMAHIEU

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Appeal No. 98-2812  
Application 08/473,054<sup>1</sup>

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ON BRIEF

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Before COHEN, FRANKFORT and PATE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4 and 6 through 19, which are all of the claims remaining in the application. Claims 3, 5 and 20 through 32 have been

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<sup>1</sup> Application for patent filed June 7, 1995.

Appeal No. 98-2812  
Application 08/473,054

canceled.

Appellants' invention relates to an absorbent article. Independent claims 1 and 12 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix A of appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Zehner et al. (Zehner '453)	5,366,453	Nov. 22, 1994
Robinson (British)	2,209,672	May 24, 1989

In making an obviousness-type double patenting rejection of the appealed claims, the examiner has additionally relied upon co-pending patent application SN 08/475309, filed June 7, 1995.

Claims 1, 2, 4 and 6 through 19 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of the co-pending patent application SN 08/475309.<sup>2</sup>

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<sup>2</sup> Given that co-pending patent application SN 08/475309 was issued as U.S. Patent No. 5769835 on June 23, 1998, it appears that this rejection is no longer a "provisional" double patenting

Appeal No. 98-2812  
Application 08/473,054

Claims 1, 2, 4, 6, 8, 10 through 16, 18 and 19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Zehner '453.

Claim 9 stands rejected under 35 U.S.C. 103 as being unpatentable over Zehner '453 in view of Robinson.

Claims 7 and 17 stand rejected under 35 U.S.C. 103 as being unpatentable over Zehner '453.<sup>3</sup>

Rather than reiterate the details of these rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we refer to the examiner's answer (Paper No. 22, mailed December 19, 1997) and to appellants' brief (Paper No. 21, filed September 23, 1997) for a full exposition thereof.

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rejection.

<sup>3</sup> As noted on page 8 of the examiner's answer, the rejection of claims 1 and 2 under 35 U.S.C. § 103 based on Hasse (4,657,539) and Zehner '453 has been withdrawn.

OPINION

After careful consideration of appellants specification and claims, the teachings of the applied references and each of the arguments and comments advanced by appellants and the examiner, we have reached the determinations which follow.

Turning first to the examiner's rejection of the appealed claims under the judicially created doctrine of obviousness-type double patenting, we observe that appellants have not disputed the examiner's position regarding the merits of this rejection. Instead, as noted on page 3 of their brief, appellants have merely indicated their intention to submit a terminal disclaimer, which terminal disclaimer has not as of yet been filed. Accordingly, we are constrained to affirm the examiner's double patenting rejection of claims 1, 2, 4 and 6 through 19.

We turn next to the examiner's rejection of claims 1, 2, 4, 6, 8, 10 through 16, 18 and 19 under 35 U.S.C. § 102(e) as being anticipated by Zehner '453. With regard to independent claim 1, appellants essentially concede that Zehner '453 discloses appellants' claimed subject matter with the exception that Zehner '453 does not disclose or teach that the elastic strands (56) associated with the internal barrier structures (52) of the absorbent article therein are constructed or arranged such that "at

least one of the elastic strands... [has] greater elastic power than at least one other elastic strand,” as set forth in claim 1 on appeal. As for independent claim 12, appellants urge (brief, pages 5-6) that Zehner ‘453 is “completely silent with respect to an elasticized cover being unadhered to an internal barrier structure,” as is required in the last lines of appellants’ claim 12 on appeal.

It is the examiner's position regarding claim 1 on appeal that at least one of the elastic strands (56) of Zehner will “inherently” have greater elastic power than at least one of the other strands. More specifically, on page 4 of the answer, the examiner has asserted that it can be seen from Figure 4 of Zehner ‘453 that the inner elastic member (presumably the one closest to the centerline of the diaper) has a greater radius and is therefore stretched further than the outer elastic member, thereby imparting greater elastic power to the inner elastic member. Appellants argue (brief, page 4-5) that Zehner ‘453 does not disclose or teach elastic strands of different elastic power as that term is defined on page 18 of the specification and as required in claim 1 on appeal. In addition, appellants disagree with the examiner’s assumption that the elastic members (56) of Zehner ‘453 have differing radii of curvature, pointing out that such a feature is at best undeterminable from Figure 4 of Zehner ‘453 and is completely without support in the specification of that reference.

After a careful evaluation of Zehner '453, it is our opinion that the examiner's reasoning in this anticipation rejection is fraught with speculation and conjecture. Like appellants, we find the showing in Figure 4 of the applied reference to be inconclusive with regard to the purportedly different radii of curvature of the elastic members (56), and conclude that neither the applied reference nor the examiner provides an adequate factual basis to establish that the natural result flowing from following the teachings of Zehner '453 would be an absorbent article having an elasticized bumper with an elasticized cover comprising "a plurality of generally parallel elastic strands with at least one of the elastic strands having greater elastic power than at least one other elastic strand," as required in appellants' independent claim 1 on appeal. As explained in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), inherency may not be established by probabilities or possibilities, but must instead be "the natural result flowing from the operation as taught." Thus, we will not sustain the examiner's rejection of independent claim 1, or of claims 2, 4, 6, 8, 10 and 11 which depend therefrom, under 35 U.S.C. § 102(e) based on Zehner '453.

Concerning the dissenting opinion of our colleague regarding the examiner's anticipation rejection of independent claim 1 on appeal, we concede that it is possible that the elastic strands (56) in Zehner which are closest to the centerline of the diaper may have a slightly greater degree of elongation than the stands closest to the outer edge of the diaper. However, we can not say

with any degree of certainty that this is, in fact, the case. In our opinion, the showings and disclosure of the Zehner patent are simply too ambiguous to support the examiner's determination based on inherency. The evidence provided by the Zehner patent does not establish that appellants' claimed characteristic of the elastic elements is necessarily present in the diaper of that patent.

As for the examiner's rejection of independent claim 12 under 35 U.S.C. § 102(e) based on Zehner '453, we note that this claim requires an absorbent article with elasticized bumpers disposed in each of the margins, wherein each of the bumpers includes an internal barrier structure (e.g., 62 of appellants' Fig. 4) bonded to one of the margins, and an elasticized cover (64) disposed over the internal barrier structure and having lateral portions bonded to one of the margins (e.g., at 72), with the elasticized cover further being "unadhered to the internal barrier structure." While it is true that one of the embodiments described by Zehner '453 would have the elastic members (56) bonded to the top sheet (20) and not to the cushion barrier or bumper (52) as was noted by the examiner on page 7 of the answer, we observe that the disclosure of Zehner '453 is silent concerning the remainder of the top sheet or cover (20) vis-à-vis the cushion barriers or bumpers (52). Noting the similar elastic elements (50) and barrier structure (48) pointed to by the examiner in Figure 3 of Zehner '453, it appears to us that the top sheet (20) on either side of the elastic members (50) folds downwardly to conform to the sides of the barrier structure (48), with Zehner '453 being silent concerning the presence or absence of

bonding between the top sheet/cover and the sides of the barrier structure (48). Thus, again we find that the examiner's position is based on speculation and conjecture concerning exactly what is taught in Zehner '453. In this instance, it appears just as likely that the top sheet/cover (20) of Zehner '453 is adhered to the sides of the barrier structures therein, as not. Absent an adequate factual basis to support the examiner's rejection based on anticipation, we are constrained to reverse. Thus, the rejection of claim 12 under 35 U.S.C. § 102(e) based on Zehner '453, and of claims 13 through 16, 18 and 19 which depend therefrom, will not be sustained.

We must likewise reverse the examiner's rejection of claim 9 under 35 U.S.C. § 103 based on Zehner '453 and Robinson for the same reasons as noted above, since our review of Robinson reveals nothing which would supply that which we have indicated to be lacking in the disclosure of Zehner '453. Similarly, the examiner's rejection of dependent claims 7 and 17 under 35 U.S.C. § 103 based on Zehner '453 must also be reversed.

In summary:

The examiner's decision rejecting claims 1, 2, 4 and 6 through 19 under the judicially created doctrine of obviousness-type double patenting is affirmed.

Appeal No. 98-2812  
Application 08/473,054

The examiner's decision rejecting claims 1, 2, 4, 6, 8, 10 through 16, 18 and 19 under 35 U.S.C. § 102(e) as being anticipated by Zehner '453 is reversed, as is the examiner's decision rejecting claims 7, 9 and 17 under 35 U.S.C. § 103.

However, since at least one rejection of each of the appealed claims has been sustained, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

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) INTERFERENCES  
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Appeal No. 98-2812  
Application 08/473,054

Pate, Administrative Patent Judge, Concurring-in-part and Dissenting-in-part

I concur in the rejection of claims 1, 2, 4, and 6 through 19 based on the ground of obviousness-type double patenting. I also concur in the majority's reversal of the rejection under 35 U.S.C. § 102(e) of claim 12 based on the Zehner reference.

I dissent with respect to the rejection of claims 1, 2, 4, 6, 8, 10 and 11 under 35 U.S.C. § 102(e) as unpatentable over Zehner. The examiner argued that the elastic power of one of the elastic strands of Zehner must inherently be greater than the elastic power of at least one other strand. The majority states that this rejection is fraught with speculation and conjecture. I do not believe that this is so. It is my view that the examiner's finding of anticipation is based on simple logic.

The appellants have defined the claim terminology "elastic power", in the specification, in terms of the retractive force of one of the multiple elastic strands. Power and force are not the same. Be that as it may, I am constrained to use the definition appellants have used in the specification and the examiner has used in the rejection. The examiner points out that when we talk of a spring or retractive force, Hooke's Law is the operative physical relationship. The law states that the spring or retractive force is equal to the amount of displacement of the spring multiplied by the spring constant. Thus, when two identical strands are stretched to different lengths, the strand that is stretched a greater distance will generate a proportionally greater force.

Considering the strands 56 disclosed in the Zehner reference, either these strands are identical or they are they not identical to one another. If they are not identical in composition, length, etc., then the claim limitation of different elastic power is met by the Zehner disclosure. Zehner is silent with respect to whether the strands are identical. They are shown as similar in length and diameter in the figure. The appellants assume that they are identical and so argue in the brief at page 5. If we assume that they are identical, the examiner has made the finding that the inner strand is stretched to “a greater radius of curvature” than the outer strands. This finding seems plausible in view of Figure 9 which shows the elastic cushion barrier 52 as curved in use. Note, that if the elastic strands are arranged in the cushion barrier in a horizontal plane, as shown in Figure 4, the radius of curvature, as mentioned by the examiner, *is* different. The examiner’s point is well taken that the inside edges, i.e., the portions nearest the medial plane of the diaper, of the cushion barriers 52 are elongated a greater distance than the outer edges due to the curve. The greater elongation of the inner edges results in the examiner’s posited greater “elastic power” under Hooke’s Law.

While the appellants dispute the examiner’s finding of greater elongation at the inner edge of the cushion barrier, the appellants merely state that this assumption is undeterminable from the figures. My own perusal of the figures shows that this is in error. In light of the clear

Appeal No. 98-2812  
Application 08/473,054

showing of the curvature of the cushion barriers 52 in Figure 9, I conclude that Zehner necessarily discloses elastic strands 56 of differing elastic power as that terminology has been defined by appellants. I would affirm this rejection.

I would also affirm the 35 U.S.C. § 103 rejections of dependent claims 7 and 9, inasmuch as appellants premise the allowability of these claims on the absence of the differing elastic power limitation of claim 1.

WILLIAM F. PATE, III  
Administrative Patent Judge

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Appeal No. 98-2812  
Application 08/473,054

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